

REMARKS

Claims 46 – 67 are pending and at issue. In the immediately prior office action, the examiner confirmed that these claimed recited allowable subject matter, but rejected the claims because an updated supplemental reissue declaration had not be submitted. In response, applicant filed a supplement declaration, executed by the inventors in the Fall of 2007 and covering all corrections made during prosecution. The examiner rejected that supplemental declaration in the current office action, because of an apparent misbelief that the supplemental declaration was merely a re-submission of a prior declaration. Applicant's representative discussed this mistake with the examiner on February 28, 2008, and from that discussion it is believed that this improper rejection is now removed.

The present office action now also raises, for the first time, a rejection of claims 46 – 67 under 35 U.S.C. § 112, ¶1, as not being enabled. All claims are rejected with respect to the term “organic material,” and claim 62 specifically with respect to the term “scanning the laser beam underneath the surface.” Applicant respectfully but strongly traverses for at least the following reasons.

First, it must be noted that the office action does not question the enablement of the actual laser induced breakdown techniques discussed in the application or the actual elements recited in the claims. There is no question that the applicant has sufficiently explained, for example, how to generate a laser pulse which has the recited characteristics for breakdown and how to apply such a pulse to a material. There is no question the application has sufficiently explained ways of determining the conditions (such as satisfactory pulse width durations) for laser induced breakdown in a material, indeed any material. The office action raises no issue with respect to any of the actual elements recited in the claims; and for this reason alone, the enablement rejection appears to be misplaced.

Second, a specification is measured based on whether it is enabled to the person skilled in the art; and the onus is on the examiner to establish at least a *prima facie* showing that such a person would not be able make or use the claimed invention after reading the application. MPEP 2164. Here, the examiner offers no evidence that the person skilled in the art, now charged with knowledge about affecting laser induce breakdown in tissue such as the cornea, would not be enabled to do the same in organic material more broadly. The

examiner, for example, points to nothing that suggests a lack of predictability in applying the disclosed techniques to other materials. This omission is particularly glaring in our view given that the claims not only reference organic material, but they recite organic material characterized by properties like that of the corneal tissue exemplified in the application, e.g., having a log-log relationship between fluence threshold at which breakdown occurs versus laser pulse width. In any case, there is no basis for concluding that the person of ordinary skill in the art applying the recited methods to some organic material of certain characteristics would not apply those same methods to other organic material with those characteristics or to determine which other organic material exhibited those characteristics. One need only look to the traditional undue experimentation test for non-enablement and see that the examiner has not established a *prima facie* lack of enablement.

Third, regarding the suggestion that enablement for “a single species of a genus does not enable the entire genus in a art area that is unpredictable,” this rationale is neither legally nor factually supported. It is well known that as long as the specification discloses “at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim,” then enablement is established. MPEP 2164.01(b) citing *In re Fisher*, 427 F.2d 833 (CCPA 1970). To this point, the MPEP specifically instructs that the presence of “only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure.” MPEP 2164.02. Enablement must be assessed with all other factors of consideration, such as the amount of direction provided in the application, the level of one of ordinary skill, and the quantity of experimentation needed to make or use the invention. *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988). And regarding the later, trial and error does equate to undue experimentation (see, e.g., *Koito Mfg. v. Turnkey*, 381 F.3d 1142 (Fed. Cir. 2004); neither does the complexity of the experimentation equate to undue experimentation. MPEP 2164.01. Indeed, empowered with applicant’s disclosure, the far more likely scenario is that the person skilled in the art would find it a relatively straightforward matter to apply the recited methods to any manner of organic material.

For at least the foregoing reasons, applicant respectfully but strongly traverses the rejections of claims 46 – 67 as not enabled.

With respect to the specific rejection of claim 62, applicant again respectfully, but strongly traverses. Per the abstract, the application describes methods in which a “beam is focused to a point at or beneath the surface of a material.” The abstract does not limit such a recitation to a particular type of material. Moreover, reading on, the next two sentences of the abstract state that this beam “may be moved in the x, y, and z directions to produce desired features.” One of ordinary skill in the art would readily understand such descriptions are pertaining to “scanning” a laser beam “at or beneath the surface of a material.” The written description goes on to provide some specific examples of the same. See e.g., FIG. 1, the transparent material example of col. 7, and the discussion of Z axis movement at col. 11. Yet other examples would be known to persons skilled in the art upon reading the application.

In short, the outstanding rejections are traversed.

This case is in condition for immediate allowance and confirmation of the same is respectfully requested.

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Respectfully submitted,

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